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In re Application of
LAZAREV, et al.
U.S. Application No. 09/485,329
PCT No.: PCT/RU98/00251
Int. Filing Date: 03 August 1998
Priority Date: 11 August 1997
Attorney Docket No.: U 012599-9
For: DICHROIC POLARIZER

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to "REQUEST FOR CORRECTED FILING RECEIPT" filed 26 July 2000 and "RESPONSE TO DECISION ON PETITION UNDER 37 CFR 1.47(a)" which is being treated as a renewed petition under 37 CFR 1.47(a) filed 01 December 2000. In a decision dated 07 November 2000, the "PETITION UNDER 37 CFR 1.47(a)" filed 17 May 2000 was dismissed because applicant did not provide adequate proof that joint inventors, Alexandr Alexandrovich Miroshin, Nicolai Vladimirovich Malimonenko and Sergei Vasilievich Belyaev, refused to execute the application or could not be reached after diligent effort and applicant did not provide a statement of the last known address of the non-signing inventors.

DISCUSSION

A. Request for Corrected Filing Receipt

A review of the application file and other Patent and Trademark Office records reveals that the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not been completed as indicated in the Filing Receipt mailed by the DO/EO/US on 10 July 2000. Specifically, the oath or declaration requirement under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America has not been satisfied. As such, the 10 July 2000 Filing Receipt was erroneously mailed by the DO/EO/US and must be vacated.

B. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. The 07 November 2000 decision indicated that petitioner has satisfied items (1) and (4) above.

Regarding item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

"Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition does not include sufficient factual proof that joint inventors, Alexandr Alexandrovich Miroshin, Nicolai Vladimirovich Malimonenko, and Sergei Vasilievich Belyaev refused to execute the application or could not be reached after diligent. The "Declaration" of Vladimir Biriulin states in paragraph three that, "Messr. Miroshin and Belyaev have received a form of Declaration (and) they did not sign it..." The declaration is accompanied by letter to Alexandr Alexandrovich Miroshin, Nicolai Vladimirovich Malimonenko and Sergei Vasilievich Belyaev. Applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to

Messr. Miroshin and Belyaev. Additionally, Mr. Biriulin alleges that inventor Nicolai Vladimirovich Malimonenko could not be found because "he was on a business trip abroad." As stated above, the fact that a non signing inventor is on vacation or out of town is not an acceptable reason for filing under 37 CFR 1.47. Moreover, no documentary evidence to support the failed attempts was provided in Mr. Biriulin's declaration. Furthermore, it does not appear that Mr. Biriulin has first hand knowledge of all the facts. It is noted that the letter to the missing inventors were mailed by Carl Cobb, not Vladimir Biriulin.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Alexandr Alexandrovich Miroshin, Nicolai Vladimirovich Malimonenko and Sergei Vasilievich Belyaev and when such papers were sent and that the nonsigning inventors have subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the above reasons, it would not be appropriate to accept this application without the signatures of Alexandr Alexandrovich Miroshin, Nicolai Vladimirovich Malimonenko and Sergei Vasilievich Belyaev at this time.

Regarding item (3) above, applicant has not provided a clear statement of the last known address of the non-signing inventor.

CONCLUSION

The Request for corrected Filing Receipt is **DISMISSED** without prejudice and the renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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